

Remarks

Applicants include herewith a Petition for a one month extension of time to reply, along with the appropriate fee.

Claims 1-4 and 24-42 are cancelled.

Claim Rejections - 35 USC § 112

(Office Action paragraph 2, page 3) **Claim 21 is rejected under 35 U.S.C. § 112 because non-glass is considered not enabled for every non-glass material.**

Applicants respectfully submit that it is only necessary that one non-glass material element be enabled by the specification to support this claim limitation. The application on page 23, lines 8-10 list the following non-glass materials: plastic, lexan, polycarbonates, acrylics, any suitable materials discussed hereinbefore

(Office Action, paragraph 3) **Claim 5 is rejected under 35 U.S.C. § 112 as failing to comply with the written specification due to the use of "filter material" not being set forth in the specification as mounted within the one or more transparent materials, and for filtering light.**

As noted in the Office Action, Applicants' original motivation was to clarify the term "wire mesh." However, in so doing, Applicants noted that it is also fair to say that use of "filter material" is not disclosed or contemplated by Eckart, potentially removing Eckart as a reference under 35 U.S.C. 102(b) and 103(a), a matter discussed subsequently. Accordingly, Applicants have moved the limitation to claim 6 and wish to present evidence that there is clearly support in the specification under 35 U.S.C. § 112 for the term "filter material" as being mounted within the one or more transparent materials.

The specification on page 28, 2nd paragraph reads that Figures 10-12 show variations of use of mesh in panels 10. There is no reason to believe that panel 10 does not refer to and include any previous discussions of panel 10 and any embodiments thereof. Directly subsequent discussion of filter material in the same paragraph provides another type of mesh used in panels 10. Thus, the filter material is mounted in the panel as previously described in connection with discussion of panel 10.

Subsequently, the same paragraph goes on to state that Fig. 10 may provide a working screen for filtering particles whereby an uncovered portion of the panel in the central region of Fig. 10 could be used for filtering particles. View of Fig. 10 shows what can only be one continuous screen bonded in panel 10 with only the circular region being uncovered filter material, and with the remainder being covered. Figure 10 is clear on this construction. Accordingly, an explicit example is provided of filtering material mounted within the translucent material of panel 10 as described in detail throughout the specification, and as set forth by claim 5. The claim language needs no further support than this one example.

With respect to the stated range of openings, the discussion of panel 10 throughout the specification provides clear support although filter material will most likely be limited to the lower portion of the range.

It is also respectfully submitted that the Office Action has concluded that there is support for a range of openings and many others in Eckart, even though Eckart is completely silent on these features. Applicant has respectfully disagreed that Eckart discloses most of these features. However, given the explicit discussion of panel 10 in Applicants' specification which actually does discuss a range of openings, it would not be reasonable to say that these features are somehow found in Eckart, and to say these features are not supported by Applicant's specification.

(Office Action paragraph 4) Claim 6 is rejected under 35 USC § 112 due to the

absence of the terminology "chicken wire" in the specification. Accordingly, claim 6 is amended to remove the language upon which the rejection is based as discussed above.

Claim Rejections - 35 USC § 102/103

Claims 5,7, 9, 11-12, and 21-22 stand rejected under 35 U.S.C. 102(b) as unpatentable over Eckart et al (US 5998028).

Establishing anticipation under 35 U.S.C. §102(b) requires that a single prior art reference contain every element recited in the claim in as complete detail as is contained in the claim. "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir 1989) See also M.P.E.P. (Manual of Patent Examining Procedure) § 2131. Further, "[A]nticipation requires that ... the prior art reference must be enabling, thus placing the alleged disclosed matter in the possession of the public." *Akzo n.v. v U.S. Int'l Trade Commission*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (C.C.P.A. 1964). "There must be no difference between the claimed invention and the reference disclosure..." *Scripps Clinic & Research Foundation v. Genetech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed Cir. 1991).

In order to establish a prima facie case under 35 U.S.C. 103(a) all the claim limitations must be taught or suggested by the prior art. The showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2s at 1232. See M.P.E.P. 2143.03.

Amended Claim 6

With respect to claim 6, Eckart clearly does not explicitly disclose use of filter material as the mesh.

Use of filter material is not an “inherent” feature taught by Eckart. “Inherency” requires that the undisclosed feature is necessarily present.

To serve as anticipation when the reference is silent about the asserted, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill”

Continental Can Co. USA v Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991) (Underlining added)

Clearly, filter material is not “necessarily present” in Eckart. Therefore, the feature is not “inherently” shown by Eckart. Accordingly, because this feature is not shown expressly or inherently, the rejection based on 35 U.S.C. 102(b) over Eckart is traversed.

To show obviousness, there must be a motivation to make the claimed invention. Eckart has no concept of using filter material whether covered or uncovered, and no motivation to do so. Moreover, Eckart utilizes his thermoplastic panels to control light but has no appreciation that the mesh may provide a more desirable means for controlling light. (Col 3, lines 53-57)

Because Eckart does not recognize the benefits of controlling light with mesh, any such results are “unexpected” with respect to Eckart. Based on Eckart, there is no “predictable” result at the time of Applicants’ invention because Eckart clearly does not contemplate this feature.

In any case, as best as can be determined by Applicants, the law does not require that

Applicant show the results are unexpected to rebut obviousness. Unexpected results are only one possible way of showing nonobviousness. More traditionally, it is only necessary to rebut that there is any motivation that it would be obvious to modify Eckart to include this feature or to show that Eckart does not show all the claim features. Clearly Eckart intends to control light differently, and does not show any possible use for filter material. Accordingly, it is not obvious to one of skill viewing Eckart to use filter material in the panel.

Claims 7, 9, 10 (Office Action, paragraph 5)

Eckart does not explicitly teach that the wire mesh of the panel created by Eckart is more reflective on a first side than on a second side. Regarding claims 9 and 10, Eckart does not teach the use of round wires and planar wires in the same weave as per claim 9 or different wire cross-sections in the same weave as per claim 10.

The Office Action states that it is Applicant's burden to show that Eckart does not "inherently" show a panel that is more reflective on one side than the other when Eckart does not explicitly disclose this feature. To satisfy this burden, as stated above, Applicants need only show that this feature is not "necessarily" present in Eckart. There is no reason whatsoever to believe that this feature is necessarily present in Eckart because Eckart as described in detail in the Eckart specification would operate fine without this feature..

Moreover, this feature is not "enabled" by Eckart. "Anticipation requires that ... the prior art reference must be enabling, thus placing the alleged disclosed matter in the possession of the public." It is difficult to see how Eckart could possibly satisfy the requirements for anticipation. Accordingly, the rejection is respectfully traversed with respect to claim 7.

With respect to claims 9 and 10, while Eckart discloses "wires, rods, or bars," Eckart does not disclose the use of two different cross-section type wires in the same weave. This is an unusual weave, not commonly used in the art, and there is no reason to believe that Eckart appreciates the aesthetics of this weave, or its functionality in controlling light. It is clearly not inherently present in Eckart. There is no motivation to provide this weave based on Eckart.

Thus, it is not obvious. Accordingly, the rejection to claims 9 and 10 is respectfully traversed.

Claims 8, 10, 13-20, 23 and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart, as applied to claim 5 above.

In order to establish a prima facie case under 35 U.S.C. 103(a) all the claim limitations must be taught or suggested by the prior art. The showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2s at 1232. See M.P.E.P. 2143.03.

(Office Action paragraph 6, p. 6) **Regarding claim 8 and 43, which disclose triangular wires, the Office Action states that it would be obvious to one of skill in the art to select a variation to create the intended effect.** However, Eckart does not disclose any recognition that light may be more suitably controlled using the mesh than by using Eckart thermoplastic sides. To the extent Eckart discusses control of light at all, he discloses controlling light by coloring his thermoplastic sides (Col. 3, line 53-57) to control light with the mesh. Eckart does not seem concerned with the “intended effect” of the mesh at all. Eckart admittedly does not show triangular wire. Again, triangular wire is not at all common. It is not “inherently” shown by Eckart.

The Office Action appears to rely on uncited case law that requires a showing of “unexpected results” to rebut obviousness. Applicants are not aware of any such case law. It is Applicants’ understanding that to rebut a case of obviousness, it is not necessary or required to show that any results are “unexpected.” This is not the law as can best be determined by Applicants. However, in any case, Applicants submit that controlling light with triangular wire would be “unexpected” and “unpredicted” based on Eckart, because Eckart does not

contemplate any method of controlling light except by the use of shading in the thermoplastic sides.

More traditionally, obviousness involves the question of motivation to modify Eckart to create the claimed invention. There is no reason to believe it would be obvious to utilize triangular wire in the first place, and especially because Eckert states no concern about an "intended effect" that would be produced by the mesh itself, rather than by the glass sides, which Eckert does seem to be concerned about.

The Office Action also states that if aesthetics are the only differences then unexpected results must be shown. Applicants submit that more than aesthetics is involved. It is not true that a window, for example, is purely aesthetic and not functional. In any case, even if aesthetics were the only design consideration, this is also not the law as best can be determined by Applicants. The MPEP 2144.04 even states it is not even appropriate to rely on case law unless there is a case that matches the situation. The MPEP, Section I gives cases that present a mixed view on the law of purely aesthetic design changes, even if that were the situation here.

Accordingly, regarding the pertinent question of whether there is a motivation to create Applicant's claimed invention. There is no motivation suggested by Eckart.

(Office Action paragraph 6, p. 6) **Regarding claims 44 and 45, it is appreciated that by using two different types of wires in certain weaves, the panel can be made non-symmetrical, such as by making one side of the panel very flat as shown in Fig. 1, especially as a tighter weave than illustrated.** This is a very unusual weave when using two different types of wires. Eckart does not remotely suggest this possibility. This weave is not inherent. It is not "predictable" to choose one weave out of thousands wherein Applicants have set forth specific advantages that Eckart has no awareness of. There is no motivation to make this combination. Accordingly it is not obvious.

(Office Action paragraph 6, p. 6) **Regarding claim 46, a weave with flat knuckles can**

be used to produce a mirror- like surface, except for the openings which may vary as claimed. Eckart does not suggest anything like this. It is inconceivable that to pick this particular weave from the thousands of possible weaves because Eckart is not aware of the benefits thereof within a panel. Although Applicants respectfully submit that it is not necessary to rebut a case of obviousness, this type of surface is not "predictable" from Eckart. Eckart is not enabling. According the rejection is traversed.

(Office Action paragraph 6, p. 6) **Regarding claim 47, both the transparent material and the wire mesh are different on each side.** Eckart simply does not teach either of these features, much less both combined together. Although Applicants respectfully submit it not necessary to rebut a case of obviousness, this type of surface is not "predictable" from Eckart. It is not obvious because there is no motivation.

(Office Action paragraph 6, p. 6) **Regarding claims 13-16, although Applicants have admitted that these weaves are well known in the art, the aesthetic and practical use of such weaves in an architectural panel is clearly not appreciated in the art.** Eckart is typical and shows no appreciation of different weaves. Applicants respectfully submit it not necessary to rebut a case of obviousness by showing a combination is not "predictable," and this type of surface is not "predictable" from Eckart. Applicants have chosen these particular weaves from among the large number of different types of weaves because Applicants believe they are especially useful in Applicants' design, due to their ability to reduce knuckles (the raised wire intersections) to virtually flat levels, as explained in some detail in the specification. Accordingly, with flat or relatively flat knuckles, these weaves produce special visual effects that are both aesthetic and functional. In one implementation, a tight weave may even produce something approaching a mirror like effect, if desired. Given that the prior art is devoid of any appreciation of the aesthetic effects of different weaves, regardless of the aesthetic effect, there is no motivation to select the specific and particular weaves claimed by Applicants as showing unusual effects.

Accordingly, the rejections are respectfully traversed based on the comments and amendments to the claims.

Summary

Applicants submit that the amendments and comments provided above now place the application in condition for allowance.

Respectfully submitted,

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